

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ESER KANDOGAN and SHUMIN ZHAI

Appeal 2006-2955
Application 09/991,140
Technology Center 2600

Decided: March 29, 2007

Before MAHSHID D. SAADAT, JEAN R. HOMERE, and JAY P. LUCAS,
Administrative Patent Judges.

SAADAT, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-37, which are all of the claims pending in this application.

We affirm.

BACKGROUND

Appellants' invention relates to entering letters on a phone keyboard by using two keys in a single row or column for specifying each letter. An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A method of electronically selecting language characters, comprising:
 - providing a keyboard that includes a plurality of keys, in which:
 - each of the numerals 0 through 9 inclusive is displayed on a respective one of the keys, each of at least 8 of the numeral-displaying keys further having language characters displayed thereon;
 - for each one of said 8 keys, a plurality of the characters displayed thereon have respective associated markings such that any given character marking on that key is uniquely identified with a single displayed character; and
 - a plurality of the keys display respective markings that visually match the character markings;
 - selecting a first character displayed on a first one of said 8 keys, wherein the first character has a first marking, by first selecting the first key with a user's finger or stylus and then selecting a key displaying the first marking with the user's finger or stylus; and
 - selecting a second character displayed on the first one of said 8 keys, wherein the second character has a second marking, by first selecting the first key and then selecting a key displaying the second marking, in which the selected key displaying the first marking and the selected key displaying the second marking are different.

The Examiner relies on the following prior art references:

Smith	US 4,585,908	Apr. 29, 1986
Stone	US 4,555,193	Nov. 26, 1985
Prame	US 4,988,997	Jan. 29, 1991
Novel	WO 94/154431	Jul. 7, 1994

The rejections as presented by the Examiner are as follows:

1. Claims 1-25 and 28-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stone, Novel, and Smith.
2. Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stone, Novel, and Smith and further in view of Prame.

Rather than reiterate the opposing arguments, reference is made to the Briefs and the Answer for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered (37 C.F.R. § 41.37(c)(1)(vii)).

ISSUE

The issue is whether Applicants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a) (2004). Appellants focus on Stone's concurrent actuation of keys and argue that such method is not the same as the claimed method where the same finger or stylus makes two separate key selections (Br. 10-16; Reply Br. 2-3). The issue turns on whether the combination of Stone with Novel and Smith teaches or suggests the claimed subject matter. Specifically, the issue is:

whether the prior art teachings disclose or suggest the claimed subject matter including key selection with a user's finger or stylus and then making a second selection using the user's finger or selection?

FINDINGS OF FACT

Appellants' claim 1 requires selecting a first character having a first marking on a first one of said 8 keys by first selecting the first key with a

user's finger or stylus and then selecting a key displaying the first marking with the user's finger or stylus.

Stone teaches that a character printed on one of the keys is selected by actuation of the key on which it is printed concurrently with actuation of another key from the same field whose background color is the color of the character (Stone, col. 3, ll. 32-38).

Novel teaches using a portable telecomputer device having a telephone keypad which usually comprises numerals 0 through 9 of which at least 8 have language characters displayed thereon (Novel, Abstract).

Smith teaches the use of a telephone keypad used to enter alphanumeric data by successively depressing two keypad buttons (Fig. 2; col. 3, ll. 20-29).

PRINCIPLES OF LAW

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987-988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Moreover, in evaluating such references it is proper to take into account not

only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

ANALYSIS

The Examiner correctly points out that claim 1 does not necessarily require using the same finger to make another selection after the first key selection is made (Answer, 11). The claim merely recites selecting the second key with “the user’s finger or stylus” which includes using the user’s other finger or selecting the second key without releasing the first key. In either case, the claimed limitation would have read on a concurrent selection of the two keys, as disclosed by Stone. In other words, the claims are not necessarily limited to sequential key strokes using the same finger.

Although the Specification is directed to a sequence of key strokes, holding the first selected key while the second key is selected is not precluded. The claims also allow for a broader interpretation that includes using different fingers for key selection or even concurrent key strokes.

Therefore, based on the teachings of Stone, Novel, and Smith outlined *supra*, and to the extent claimed, we agree with the Examiner’s position that the claimed key selection reads on the prior art concurrent key selection. Accordingly, we remain unconvinced by Appellants’ assertion that the Examiner erred in rejecting Claim 1 under § 103(a) over the combination of Stone with Novel and Smith. Similar to claim 1, independent claims 13, 24, and 25 include limitations directed to the layout of the characters on a telephone keypad and the two-key selection of each character, which are shown to be taught or suggested by the applied prior art. Therefore, we sustain the 35 U.S.C. § 103 rejection of independent claims 1, 13, 24, and

25, as well as their dependent claims 2-12, 14-23, 25, and 28-37 over Stone, Novel, and Smith.

With respect to the rejection of claims 26 and 27, we note that Appellants rely on the same arguments presented for their base independent claims (Br. 25). In view of our analysis above, we also sustain the 35 U.S.C. § 103 rejection of claims 26 and 27 over Stone, Novel, Smith, and Prame.

CONCLUSION

On the record before us, Appellants have failed to show that the Examiner has erred in rejecting the claims or the rejection is not supported by a legally sufficient basis for holding that the claimed subject would have been obvious within the meaning of § 103(a).

DECISION

The decision of the Examiner rejecting claims 1-37 under 35 U.S.C. § 103 is affirmed.

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AFFIRMED

ELD

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